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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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PATRICIA A. WENGER 201 NORTH JACKSON STREET MEDIA, PA 19063			EXAMINER MAI, HUY KIM	
			ART UNIT	PAPER NUMBER
			2873	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/648,508

Applicant(s)

BRZOZOWSKI, FRANK T.

Examiner

Huy K. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-87 is/are pending in the application.
- 4a) Of the above claim(s) 74-76 and 85 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 58-73 is/are allowed.
- 6) ☒ Claim(s) 35,36,38-56,77,78,80-84,86 and 87 is/are rejected.
- 7) ☒ Claim(s) 37,57 and 79 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Huy Mai
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Karasawa (5,663,779).

The limitations in claims 35 and 36 are shown in Karasawa's Figs. 4, 8, column 4, line 20 through column 6, line 11. Karasawa discloses an eyewear lens system, said system comprised of at least one rotator 52, wherein said rotator 52 is comprised of a turning member 52.

Regarding claim 36, Karasawa discloses said eyewear system further comprising a peripheral member 44 and a peripheral edge 60, said peripheral member 44 engaging said peripheral edge 60, said turning member 52 being attached to said peripheral member 44.

3. Claims 35 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Erhard (1,401,327).

Regarding claim 35, Erhard (Figs 1-4, page 1, column 1, line 38 through column 2, line 69) discloses eyeglasses comprising a lens 5-8 and a peripheral member 2 wherein friction between the user's finger and the edge of the lens causes the lens rotate relative to the peripheral member 2 and thus, Erhard's eyeglasses inherently included a rotator and/or a turning member.

Regarding claim 46, Erhard discloses an eyewear system comprising a containment structure 2, at least one lens 5-8 being rotatable within the containment structure 2 wherein the

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friction between the user's finger and the edge of the lens causes the lens rotate relative to the peripheral member 2 and thus, the Erhard's eyeglasses inherently include a rotator.

In response to the rejection, the applicant argues, in page 2, that "Applicant submits that Examiner's rejection of claim 35, as amended, is improper, and requests reconsideration. According to the Examiner's description of the turning member in Erhard, the turning member is the lens itself. However, claim 35 includes a "turning member", (emphasis added.) The word "member" is commonly described as "a distinct part of a whole"(see yourDictionary.com.) Accordingly, pursuant to the Examiner's description, the portion of the lens labeled by the Examiner as a "turning member" actually is not distinct part of the whole, and therefore it is a portion, not a member, of a lens system".

In reconsideration, the rejection to claim 35 over Erhart under 35 USC 102 is clear and proper. The peripheral member 2 wherein friction between the user's finger and the edge of the lens causes the lens rotate relative to the peripheral member 2 and thus, Erhard's eyeglasses inherently included a rotator and/or a turning member. Erhart discloses the inherency of "a rotator and/or a turning member". Erhart (page 1, lines 63-68) discloses "A person desiring to use the portion 5 ... would, by placing his finger in contact with the edge of the lens projecting beyond the inwardly set portion of the frame and rotating the lens" and claims (claim 1, lines 3-7) "a portion of the frame being set inwardly to define a pair of shoulders and to expose a portion of the periphery of the lens thereby to facilitate the rotation of the lens". It appears that the applicant is contradictory to himself in his arguments because his arguments are based on the dictionary "yourDictionary.com", but not based on what the applicant discloses in the original specification. The applicant discloses (page 24, lines 5-8) that "The rotator could be a turning member 90a, and it could also be "any means" (emphasized) for rotating a lens, including, but not limited to the pressure exerted by fingers grasping the lens" and (page 24, lines 13-16) that

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“The turning member 90a may be attached to the lens by “means known in the art” (emphasized) ..., but is not limited to, glue, “molding” (emphasized), ... and the like”. Therefore, the applicant’s turning member 90a is not "a distinct part of a whole" as argued; but could be any means for rotating a lens, including, but not limited to the pressure exerted by fingers grasping the lens and may be attached to the lens by molding as disclosed.

The applicant does not point out how the rotator and/or the turning member in claim 35 patentably distinct from the lens system in the Erhart reference.

In response to the rejection, the applicant also argues, in page 2, that “Regarding claim 46, Applicant submits that Examiner's rejection is improper, and requests reconsideration. Specifically, Erhard is for eyeglasses or spectacles, and claim 46, as amended, is for a group of headwear consisting of welder's eyewear, motorcycle rider eyewear, safety eyewear, skydiving eyewear, airplane pilot eyewear, gas mask eyewear, hazardous materials eyewear, 3-d glasses, costumes, masks, goggles, hoods, UV tanning eyewear, racecar driver eyewear, astronaut eyewear, sports eyewear, hoods and helmets.”

In reconsideration, the rejection to claim 46 over Erhart under 35 USC 102 is proper. It is true that the Erhart’s configurable eyewear system is for eyeglasses or spectacles. The applicant’s eyewear system does not exclude from a group including the eyeglasses and spectacle. In fact, the applicant (page 3, line 19 through page 4, line 6) discloses that “The lenses and eyewear of the invention can used in a headpiece. The terms headpiece and eyewear are intended to include “all kinds of eyewear” (emphasized) that can include lenses for the eyes. As such, the terms headpiece and eyewear is intended to include, but is not limited to eyeglasses, prescription eyeglasses”, ..., 3-d glasses, ..., UV tanning eyewear, ...and the like”. Thus, it is clear that claim 46 (as amended) is for a group of headwear including eyeglasses as disclosed in the original specification. Furthermore, if the applicant’s eyewear system is for, for example, UV

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tanning eyewear, i.e., his eyewear system provides a function of UV tanning, the Erhart's eyewear system also provides a function of UV tanning because the same structure would provide the same function; otherwise, the applicant should demonstrate that his claimed invention in claim 46 provides the function of UV tanning, but the Erhart's eyewear system does not.

The applicant does not point out how the claimed invention in claim 46 is patentably distinct from the lens system in the Erhart reference.

4. Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Lin (4,998,815).

Lin (Figs. 1 and 2, column 2) discloses an eyewear lens 1, said lens 1 comprising an anchor cut-out 11, said cut-out 11 having an opening area (12,13) and an inner area, said inner area being wider than said opening area.

5. Claims 46, 47, 49, 50 and 86 are rejected under 35 U.S.C. 102(b) as being anticipated by Karasawa.

The limitations in claims 46, 47, 49 and 50 are shown in Karasawa's Figs. 5-10, column 5, line 45 through column 6, line 11. Karasawa discloses in Figs. 5-10, a configurable eyewear system, said eyewear system comprising at least one containment structure 11 and at least one lens 56, said at least one lens being rotatable within said containment structure 11, said eyewear system further comprising at least one rotator (102, 243), and said at least one lens 56 being rotatable at least by said rotator.

Regarding claim 86, Karasawa (Figs. 15-17, column 8, lines 48-68) discloses a configurable eyewear system, said eyewear system comprising sealing means, at least one

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containment structure 11 and at least one lens 56, said at least one lens being rotatable within said containment structure 11, said eyewear system further comprising at least one rotator (544), and said at least one lens 56 being rotatable at least by said rotator wherein said eyewear system is headwear can be used under water.

In response to the rejection, the applicant argues, in page 3, that "Applicant submits that Examiner's rejection is improper, and requests reconsideration. Karasawa is for polarized spectacles, and claim 46, as amended, is for a group of headwear consisting of welder's eyewear, motorcycle rider eyewear, ..., UV tanning eyewear, ... and helmets. In the amendment, sunglasses have been removed from the group of headwear".

In reconsideration of the applicant arguments to claim 46 over the Karasawa reference, the rejection to claims 46, 47, 49 and 50 over Karasawa under 35 USC 102 is proper. It is true that the Karasawa's configurable eyewear system is for polarized spectacles or sunglasses. The applicant's eyewear system does not exclude from a group including the sunglasses. In fact, the applicant (the specification, page 3, line 19 through page 4, line 6) discloses that "The terms headpiece and eyewear are intended to include "all kinds of eyewear" (emphasized) that can include lenses for the eyes. As such, the terms headpiece and eyewear is intended to include, but is not limited to ... sunglasses, ...UV tanning eyewear, ...and the like". Thus, it is clear that claim 46 (as amended) is for a group of headwear including sunglasses as disclosed in the original specification. Furthermore, if the applicant's eyewear system is for, for example, UV tanning eyewear, i.e., his eyewear system provides a function of UV tanning, the Karasawa's eyewear system also provides a function of UV tanning because the same structure would provide the same function; otherwise, the applicant should demonstrate that his claimed invention in claim 46 provides the function of UV tanning, but the Karasawa's eyewear system does not.

Removing the word “sunglasses” from the group of headwear does not make claim 46 patentable over the Karasawa reference. The applicant does not point out how the claimed invention in claim 46 is patentably distinct from the lens system in the Karasawa reference.

6. Claims 46, 47, 51-56, 77, 78 and 80-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey (1,471,996).

The limitations in claims 46, 47, 51-56, 77, 78, 80-84 and 87 are shown in Bailey's Figs. 1-7, pages 1-2. Bailey discloses a configurable eyewear system, said eyewear system comprising at least one containment structure 7 and at least one lens 1, said at least one lens being rotatable within said containment structure, said eyewear system further comprising one turning member 4, said at least one lens 1 being rotatable at least by said turning member 4, said system further comprising at least one peripheral member 3, said turning member 4 being attached to said peripheral member 3, and wherein said at least one lens further comprises a peripheral edge, said peripheral edge having at least one mating member, said at least one peripheral member 3 having at least one mating member, said peripheral member mating member engaging said peripheral edge mating member (see Fig. 6).

Regarding claims 51 and 80, the containment structure includes the bridge and/or guide 8, wherein the operating member 9 slides the turning member 4 between a first position (see Fig. 3) and a second position (see Fig. 4) and therefore, the guide 8 inherently includes stop members (see Fig. 5).

Regarding claim 56, Bailey claims in claim 5 a pair of multifocal lenses.

Regarding claim 87, Bailey discloses the claimed structure limitations wherein the eyewear system comprising at least one containment structure 7 and at least one lens which has

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at least two optical portions as the same as that claimed in claim 87. Since the same claimed structure limitations, the Bailey's eyewear should do the same function as sunglasses as the applicant does in claim 87.

In response to the rejection, the applicant argues, in page 4, that "Regarding claims 46, and 51-55, Applicant submits that Examiner's rejection is improper, and requests reconsideration. Bailey is for spectacles and nose glasses, and claims 46, and 51-55, as amended, are for a group of headwear consisting of welder's eyewear, motorcycle rider eyewear, safety eyewear, skydiving eyewear, airplane pilot eyewear, gas mask eyewear, hazardous materials eyewear, 3-d glasses, costumes, masks, goggles, hoods, UV tanning eyewear, racecar driver eyewear, astronaut eyewear, sports eyewear, hoods and helmets.", "Regarding claims 77, 78, 80 - 84, Applicant submits that Examiner's rejection is improper, and requests reconsideration. Bailey does not disclose a "peripheral edge having at least one mating member", a "peripheral member having at least one mating member" or the peripheral edge mating member "engaging" the peripheral member mating member. In Bailey the connecting member is attached to the lens with a screw.", and "In addition, regarding claims 51 and 80, in addition to the distinctions listed above, claims 51 and 80 include a "stop member", (emphasis added.) The word "member" is commonly described as "a distinct part of a whole"(see yourDictionary.com.) Accordingly, pursuant to the Examiner's description, the portion of the containment structure labeled by the Examiner as a "stop member" is not a distinct part of the containment structure, and therefore is actually a portion of the bridge and/or guide, not a distinct member of the containment structure".

In reconsideration of the applicant arguments to claim 46 over the Bailey reference, the rejection to claims 46, and 51-55 over Bailey under 35 USC 102 is proper. It is true that the bailey's configurable eyewear system is for spectacles. The applicant's eyewear system does not exclude from a group including the spectacles. In fact, the applicant (the specification, page 3, line 19 through page 4, line 6) discloses that "The terms headpiece and eyewear are intended to include "all kinds of eyewear" (emphasized) that can include lenses for the eyes. As such, the terms headpiece and eyewear is intended to include, but is not limited to ... sunglasses, ...UV

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tanning eyewear, ...and the like". Thus, it is clear that claim 46 (as amended) is for a group of headwear including sunglasses as disclosed in the original specification. Furthermore, if the applicant's eyewear system is for, for example, UV tanning eyewear, i.e., his eyewear system provides a function of UV tanning, the Bailey's eyewear system also provides a function of UV tanning because the same structure would provide the same function; otherwise, the applicant should demonstrate that his claimed invention in claim 46 provides the function of UV tanning, but the Bailey's eyewear system does not.

The rejection has point out and matched the elements in the reference with the elements in claims.

The applicant does not point out how the claimed invention in claims is patentably distinct from the lens system in the Bailey reference.

7. Claims 77 and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by Archambault (2,813,459).

Archambault (Figs. 1-7, columns 1-2) discloses a configurable eyewear system, said eyewear system comprising at least one containment structure 7 and at least one lens 13, said at least one lens 13 being rotatable within said containment structure 7, said eyewear system further comprising one turning member 18, said at least one lens 13 being rotatable at least by said turning member 18, said system further comprising at least one peripheral member 12, said turning member 18 being attached to said peripheral member 12, and wherein said at least one lens (Fig. 7) further comprises a peripheral edge, said peripheral edge having at least one mating member, said at least one peripheral member 123 having at least one mating member, said peripheral member mating member engaging said peripheral edge mating member (see Fig. 7).

In response to the rejection, the applicant argues, in page 5, that “Regarding claims 77 and 80, Applicant submits that Examiner's rejection is improper, and requests reconsideration. Archambault does not disclose a "peripheral edge having at least one mating member", a "peripheral member having at least one mating member" or the peripheral edge mating member "engaging" the peripheral member mating member. In Archambault, the metal strip is attached to the lens with a pin”.

In reconsideration of the applicant arguments to claims 77 and 80 over the Archambault reference, the rejection to claims 77 and 80 over Archambault under 35 USC 102 is proper. The rejection has point out and matched the elements in the reference with the elements in claims.

The applicant does not point out how the claimed invention in claims is patentably distinct from the lens system in the Bailey reference.

8. Claim 46 is rejected under 35 U.S.C. 102(b) as being anticipated by Tassier (5,956,114).

The limitations in claim 46 are readable over Tassier's Figs. 1,4,8. Tassier discloses an eyewear lens system comprising at least one lens 11 freely rotatable within the frame 2, any shake or touch and push on the surface of the lens cause the lens rotates. Thus surface of the lens can be considered a rotator.

In response to the rejection, the applicant argues, in pages 5-6, that “Regarding claim 46, Applicant submits that Examiner's rejection is improper, and requests reconsideration. Tassier is for spectacles, sunglasses and clip-ons and claim 46, as amended, is for a group of headwear consisting of welder's eyewear, motorcycle rider eyewear, safety eyewear, skydiving eyewear, airplane pilot eyewear, gas mask eyewear, hazardous materials eyewear, 3-d glasses, costumes, masks, goggles, hoods, UV tanning eyewear, racecar driver eyewear, astronaut eyewear, sports eyewear, hoods and helmets”.

In reconsideration of the applicant arguments to claim 46 over the Tassier reference, the rejection to claim 46 over Tassier under 35 USC 102 is proper. It is true that the Tassier's configurable eyewear system is for spectacles. The applicant's eyewear system does not exclude

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from a group including the spectacles. In fact, the applicant (the specification, page 3, line 19 through page 4, line 6) discloses that “The terms headpiece and eyewear are intended to include “all kinds of eyewear” (emphasized) that can include lenses for the eyes. As such, the terms headpiece and eyewear is intended to include, but is not limited to ... sunglasses, ...UV tanning eyewear, ...and the like”. Thus, it is clear that claim 46 (as amended) is for a group of headwear including sunglasses as disclosed in the original specification. Furthermore, if the applicant’s eyewear system is for, for example, UV tanning eyewear, i.e., his eyewear system provides a function of UV tanning, the Tassier’s eyewear system also provides a function of UV tanning because the same structure would provide the same function; otherwise, the applicant should demonstrate that his claimed invention in claim 46 provides the function of UV tanning, but the Tassier’s eyewear system does not.

9. Claims 77, 78 and 80-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirano (JP 7-159733).

The limitations in claims 77, 78 and 80-84 are shown in Hirano’s Figs. 1-4. Hirano discloses a configurable eyewear system, said eyewear system comprising at least one containment structure (2, 3, 23) and at least one lens 26, said at least one lens 26 being rotatable within said containment structure, said eyewear system further comprising one turning member (11, 28), said at least one lens 26 being rotatable at least by said turning member, said system further comprising at least one peripheral member (23, 7, 8), said turning member 11 being attached to said peripheral member (see Fig. 4), and wherein said at least one lens further comprises a peripheral edge, said peripheral edge having at least one mating member, said at

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least one peripheral member having at least one mating member, said peripheral member mating member engaging said peripheral edge mating member.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erhard.

Erhard discloses a configuration eyewear system comprising at least one containment structure 2 and at least one lens being rotatable with in the containment structure 2. wherein the containment structure having an interior surface and the lens having a peripheral edge (see Fig. 4). The interior surface and the peripheral edge have complement shapes. Although the interior surface and the peripheral edge in the Erhard's eyewear system does not teach the exact the shape of bezel as that claimed by applicant, the shape, size, dimension differences are considered obvious choices and are not patentable unless unexpected results are obtained from these changes. Therefore, it would have been obvious to a person having ordinary skill in this art to modify the Erhard reference by interior surface and the peripheral edge having the same shape as the applicant's. Such a modification would have no functional differences from the Erhard reference.

In response to the rejection, the applicant argues, in pages 6-7, on the same ground of the argument as discussed in claim 46. See the above discussion (paragraph # 3).

Allowable Subject Matter

12. Claims 58-73 are allowed.

13. Claims 37, 57 and 79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: The limitations of "a memory member, said memory member being attachable to eyewear having a lens whereby said memory member is able to cause said lens to rotate" are not taught or fairly suggested by the prior art or any combination thereof either under 35 USC 102 or 103. These limitations could be allowable over the prior art of record.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai
Primary Examiner
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